REMARKS

Applicants respectfully request consideration of the subject application as amended herein. This Amendment is submitted in response to the Office Action mailed June 1, 2005. Claims 1-4 and 6-20 stand rejected. In this Amendment, Claims 1, 4, 7, 19 and 20 have been amended. Claims 21-23 has been added. No new matter has been added.

35 U.S.C. § 112 Rejections

The Examiner has rejected claim 20 under 35 U.S.C. § 112 first paragraph, as failing to comply with the written description requirement. The Examiner submits that the theoretical return of a base game being increased by a bonus game is not reasonably provided for in the specification as filed.

Applicants respectfully disagree. At page 5, lines 13-14 of the specification, it is taught that "Other types of prizes other than just fixed credits, may be awarded, including free games, mystery prizes, 'next win multiplied by five' etc." Thus, written description is provided to support a theoretical return of a base game being increased (e.g., multiplied) by a bonus game.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claim 20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1-4, 6-9, 12 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over O'Halloran (U.S. Patent No. 6,450,883, hereinafter "O'Halloran") in view of Baerlocher et al. (U.S. Patent No. 5,788,573, hereinafter "Baerlocher"). The Examiner has rejected claims 10-11, 12 and 18 under 35 U.S.C. § 103(a) as being unpatentable over O'Halloran in view of Baerlocher et al. and further in view of DeMar et al (U.S. Patent No. 6,315,660, hereinafter "DeMar").

Applicants respectfully refute the Examiner's contention that the claims are obvious in light of O'Halloran and Baerlocher. The cited art fails to teach or suggest the limitation in claims 1, 14, and 17, that "each prize set has the same number of potential outcomes from which prize sets a prize is to be drawn and awarded to the player."

Applicants note the Examiner has failed to point to a teaching in the cited art for the above limitation.

Specifically, O'Halloran fails to disclose this feature as each of the available prize sets disclosed therein has a different number of cards from which the winning card must be drawn.

Baerlocher cannot disclose such a feature as it does not disclose the use of more than one prize set in its bonus round. In this regard, we believe the correct interpretation of Baerlocher is one in which the individual "wheels of fortune" do not comprise separate prize sets, but rather that the three wheels of fortune

are combined in a sequential fashion to form a <u>single prize set</u>. As taught in the citation, the wheels are used as a means for offering a jackpot prize which has a very low probability of being won (e.g. a 1 in 8,000,000 chance) in a wheel of fortune game by requiring sequential winning outcomes on each wheel. Accordingly we argue that Baerlocher cannot teach or suggest that *each prize set* [should have] *the same number of potential outcomes,* as it only teaches the use of one prize set.

If this interpretation is given to Baerlocher, the combination of documents cited by the Examiner fails to properly teach or suggest the above mentioned feature of the claimed invention.

If the Examiner rejects this interpretation of Baerlocher and prefers to view the three wheels of fortune disclosed therein as being different prize sets, we contend that Baerlocher teaches away from O'Halloran, and therefore it is improper for them to be combined in rejecting the current claims.

In this regard, if the three wheels of fortune disclosed in Baerlocher are viewed as three separate prize sets, the three prize sets will have differing returns to player. As described in column 8 lines 30 and 31 the second wheel contains "indicium values 412 which are larger than (such as twice) the amount of the first wheel values," and further at lines 2"preferably the third wheel has no bankrupt indicium 412d and the values associated with the indicia 412 are larger (such as 10 times) than those on the first wheel." Accordingly, it can be seen that not only does Baerlocher describe having increasing values on the second and

third wheels, which contribute to a relatively higher return to player than the first wheel, but it also discloses having more, rather than less winning combination on the second and third wheels, which further increase their relative return to player percentage.

If the Examiner takes this second view of Baerlocher, we submit that there would be no motivation to combine these documents as the Examiner has done in raising this objection, as they teach away from each other in regard to the theoretical return to player to be offered in a bonus game.

Thus, claims 1, 14 and 17 are patentable over the cited art. As claims 2-4, 6-13 and 18-20 depend, directly or indirectly, from one of the foregoing independent claims, claims 2-4, 6-13 and 18-20 are also patentable over the cited art.

Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1-4, 6-9, 12 and 14-17 under 35 U.S.C. § 103(a) as being unpatentable over O'Halloran in view of Baerlocher. Applicant, accordingly, also respectfully requests withdrawal of the rejections of claims 10-11, 12 and 18 under 35 U.S.C. § 103(a) as being unpatentable over O'Halloran in view of Baerlocher et al. and further in view of DeMar et al (U.S. Patent No. 6,315,660, hereinafter "DeMar").

New Claims

As noted above, Applicants have added new claims 21-23. Applicants respectfully submit the cited art fails to teach or suggest the invention as claimed in new claims 21-23.

A further difference between the present invention as claimed in new claim 21 and the systems of cited prior art is that in the present invention it is not possible to lose a prize that has been won, or a stake wagered, on the underlying game in the feature game. That is, even if a non-winning outcome occurs in the feature game, this doesn't prevent a played from winning a prize in the associated base game within the same game round or mean that the player will lose any winnings gained in the underlying game.

This feature is not present in either of the cited documents. The feature game taught by O'Halloran is a "double-or-nothing" game where a non-winning outcome on the feature game loses the prize that the player has won on the underlying game and also their wagered stake.

Similarly, in the feature game of Baerlocher, when the outcome of the wheel feature is a "Bankrupt," the player not only loses his or her prize in the feature game, but also loses the stake wagered on the base game, as shown in Figure 1.

Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call Stephen M. De Klerk at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account

No. 02-2666. Any necessary extension of time for response not already requested

is hereby requested. Please charge any corresponding fee to Deposit Account

No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: __December 1, 2005__   _____

Stephen M. De Klerk
Reg. No. 46,503

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026
(408) 720-8300